

1632



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
Paul Sanberg <i>et al.</i>)	
)	
Serial No.)	Examiner: Anne-Marie Falk
09/801,221)	
Filed:)	
March 7, 2001)	Art Unit: 1632
For:)	
HUMAN CORD BLOOD AS A)	
SOURCE OF NEURAL TISSUE)	
FOR REPAIR OF THE BRAIN)	
AND SPINAL CORD)	

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RESPONSE TO OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Responsive to the Office Communication mailed September 9, 2003, a response to which is due October 9, 2003 without an extension of time, Applicants elect with traverse β -tubulin folding cofactor D as the gene associated with neurogenesis. No other claims are readable upon the elected species.

The Office Communication states that "Claim 73 recites numerous genes associated with neurogenesis. Applicant is required to elect a single gene from those listed in Claim 73." The election requirement with respect to Claim 73 is respectfully traversed on the basis that the examination of the Markush group would not be an undue burden because of the

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 9, 2003.

William L. Warren, Reg. No. 36,714

close technological relationship of the groups of genes associated with neurogenesis. As can be clearly ascertained from the instant specification, neural cells obtained from umbilical cord blood demonstrate up-regulation of genes that are associated with neurogenesis (see Table I). However, neural cells obtained from umbilical cord blood may express a subset of genes associated with neurogenesis, such that the exact gene that is up-regulated is not critical. Certain neural cells obtained from umbilical cord blood may show up-regulation of a subset neurogenesis-associated genes and while other neural cells may differ and express a different subset of neural genes.

Furthermore, in order for a restriction requirement to be appropriate, there must be a serious burden on the Examiner to search all of the inventions and the inventions must be independent or distinct as claimed. The Examiner has not provided evidence that a search of all the neurogenesis-associated genes listed would be seriously burdensome. Section 803.02 of the MPEP states that "if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claims on the merits, even though they are directed to independent and distinct inventions." Therefore, Applicants respectfully request that the Examiner withdraw the requirement for election of a single neurogenesis-associated gene. In the alternative, Applicants request that additional members of the restricted genes be examined in this case subsequent to an indication of allowability of each examined species.

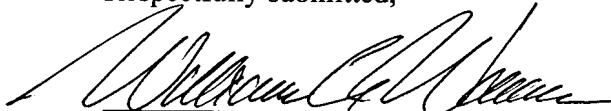
The foregoing is submitted as a full and complete response to the Office Communication mailed September 9, 2003. No additional fees are believed to be due,

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Filed: March 7, 2001
Response to Office Action

however, the Commissioner is hereby authorized to charge any additional fees due or credit any overpayment to deposit account no. 19-5029.

If there are any issues which can be resolved by telephone conference or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney at (404) 853-8081.

Respectfully submitted,



By: William L. Warren
Reg. No. 36,714

Date: October 9, 2003
SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, Georgia 30309
(404) 853-8000 / (404) 853-8081 (direct)
(404) 853-8806 (fax)

SAB Docket 20657.0005